

Application No. 09/854,718

RD-28013-2

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**ATTENTION: Refund Section
Accounting Division
Office of Finance****OFFICIAL****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of

Radislav Alexandrovich POTYRAILO

Group: 2881

Application No.: 09/854,718

Examiner: David A. VANORE

Filed: May 14, 2001

For: METHOD FOR THE RAPID DETERMINATION OF THE
OPTICAL QUALITY OF COMBINATORIAL LIBRARIES**FACSIMILE TRANSMITTAL COVER SHEET**To: Refund Section
Accounting Division
Office of Finance

This transmission includes 4 pages (including cover sheet). When facsimile receipt is returned with this cover sheet, the USPTO acknowledges receiving the following documents:

1) **REQUEST FOR REFUND TO DEPOSIT ACCOUNT (3 pages)**

Respectfully submitted,



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23 MAR, 2004

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OFFICIAL

REQUEST FOR REFUND TO DEPOSIT ACCOUNT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This is a request for a refund with respect to a March 3, 2004 deposit account charge authorization in the amount of \$ 770 to account No. 070868 purportedly in respect of a Request for Continued Examination (RCE) Transmittal. This Request is made for the following reasons.

1. Claims 1 to 11, 13 to 20, 22 to 31 and 46 to 59 are pending.
2. A December 3, 2003 Final Rejection rejected claims 1 to 20, 22 to 31 and 46 to 59 under 35 U.S.C. §102(a) over Nielsen.

I. THE DECEMBER 3, 2003 OFFICE ACTION WAS A PREMATURE FINAL REJECTION

3. Claim 47 claims a method comprising applying varying testing conditions to form a pattern of test results with intermittent untested reference spacings and "detecting radiation scattered from the pattern of test results *with the spacings*" (emphasis added).

4. Applicant's specification, paragraph [0005] points out the importance of this limitation:

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[0005] This invention provides methodology for the measurement of both low and high levels of scattered radiation produced by decorative and barrier coatings. Measurements of low levels of scattered radiation are especially important for coatings such as those used in automotive applications. The method is based on the illumination of a coating sample with an electromagnetic radiation source and collection of only a portion of the radiation scattered from the coating. Good correlation has been found between the data obtained via the practice of this invention and such data obtained via more cumbersome and inherently limited methodology such as that set forth in ASTM D 1003, and other tests. Through the practice of the invention, a large number of coating samples, as in an array, may be analyzed for their optical quality, i.e., principally haze, either after coating and curing, and/or after subjecting such coatings samples to elongation stresses and/or abrasion and hydrolytic stability testing. An advantage of this invention is that when analyzing an array, the substrate is used as a reference for comparison of the optical quality of the substrate to that of the coating sample. In such an array, the uncoated substrate areas between the individual members of the coating array or library may be utilized as internal standards. A further advantage is the capability to analyze the standards and various abraded coating regions to determine the relative performance of a member of the combinatorial array or library.

5. The claim 47 step of "detecting radiation scattered from the pattern of test results with the spacings" is a step in using the spacings as reference regions to gain the inventive advantage of an "internal standard."

6. However, the December 3, 2003 Final Rejection does not examine the claim 47 "detecting radiation scattered from the pattern of test results with the spacings" limitation.

7. The MPEP 2271 states:

.... The grounds of rejection must (in the final rejection) be clearly developed to such an extent that the patent owner may readily judge the advisability of an appeal.....

8. The December 3, 2003 Final Rejection does not address claim 47 in a developed manner to enable the Applicant to judge the advisability of an appeal.

9. Further, 37 C.F.R. § 1.104 entitled "Nature of Examination" provides that "[t]he examiner's action will be complete as to all matters...."

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10. The Final Rejection is incomplete in failing to address the claim 47 "detecting radiation scattered from the pattern of test results with the spacings"

II. CONCLUSION

11. The December 3, 2003 office action in this case was an improper final action.

12. Applicants' March 3, 2004 MPEP 706.07(c) AND MPEP 706.07(d) REQUEST TO WITHDRAW FINAL REJECTION was incorrectly not acted upon by the PTO necessitating the filing of an RCE to maintain pendency of this case.

Accordingly, it is respectfully requested that the amount of \$ 770 in respect of the RCE fee be refunded to Deposit Account No. 070868 and that the Patent Office acknowledge this refund in writing to the undersigned.

Respectfully submitted,



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